

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Rejection under 35 U.S.C. § 103(a)

1. Claims 1-45 stand rejected as allegedly being obvious in view of Beinlich et al. US 2005/0124689 (“Beinlich et al.”); Kapoor et al. US 2002/0068100 (“Kapoor et al.”); Bland et al., US 2002/0192310 (“Bland et al.”); Miller et al. US 6,426,632 (“Miller et al.”); Seikie et al. US 2003/0086981; Horrobin US 6,479,544 and 5,120,760 (“Horrobin ‘544” and “Horrobin ‘760”, respectively).

2. Claims 46-74 stand rejected as allegedly being obvious in view of Bruzzese US 5,776,978 (“Bruzzese”); Beinlich et al. US 2005/0124689 (“Beinlich et al.”); Miller et al. US 6,426,632 (“Miller et al.”); Bland et al. US 2002/0192310 (“Bland et al.”); and Mechoulam et al. US 5,618,955 (“Mechoulam et al.”).

Initially, Applicants point out that to establish a *prima facie* case of obviousness, the Office has the burden of showing the following three criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (MPEP 2143). Applicants submit that the office has not met its burden.

Applicants submit that the office has not met its burden of establishing a *prima facie* case of obviousness in either of the obviousness rejection because the office has not provided the requisite motivation to combine the references cited.

Applicants note that in the rejection of Claims 1-45, the Examiner has relied upon the combination of six references. In the rejection of Claims 46-74, the Examiner has relied upon the combination of five references. The Office Action goes into detail about the teachings of each reference; however, the action fails to provide the *motivation* to combine all of the references. The Office Action states that:

[t]he Beinlich references teaches one skilled in the art at the time of the invention was made would have obtained the same result as claimed by combining together the teachings taught be Kapoor, Bland, Miller, Seiki, and Horrobin to treat PMS or PMDD related symptoms. One of ordinary skill in the art would have known that administering to a female a non-alpha tocopherol or metabolite thereof with an omega-3 poly-unsaturated fatty acid would reduce the symptoms of PMS or inflammation.

The Office Action, pages 4-5. This argument relies on what one of skill in the art would have known rather than whether they would have combined the references teachings to arrive at the claimed invention. This is insufficient to establish a *prima facie* case of obviousness over claims 1-45 because it relies on level of skill in the art. See MPEP §2143.01.

The Office Action also states that:

One of ordinary skill in the art would have been motivated to combine the cited prior art to reduce pain in a female suffering from PMS and expect a successful result in doing so, since in the art it is well documented the use of tocopherols, omega 3, 6 or 9 poly unsaturated fatty acids in combination with flavonoids, minerals to reach in synergy and give relief to the patient.

The Office Action, page 7. This argument again relies on what one of skill in the art would have known rather than whether they would have combined the references to arrive at the claimed invention. This is insufficient to establish a *prima facie* case of obviousness over claims 46-74 because it relies on level of skill in the art. See MPEP §2143.01.

Furthermore, Applicants submit that such a multiplicity of references does not provide the requisite suggestion for one of skill in the art to combine the references to arrive at the claimed invention. See, e.g. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1383, 231 USPQ 81, 93 (Fed. Cir. 1986). Applicants contend that having to combine the teachings of the multiplicity of references relied upon evidences that the invention is *not obvious*.

In light of the above, Applicants submit that the Office has failed to meet its burden to show a *prima facie* case of obviousness and as such, the rejection should be withdrawn.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 50-0872. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-0872. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 50-0872.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

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